

REMARKS

The Official Action constitutes a final rejection of the claims. Favorable reconsideration is respectfully requested in view of the following remarks.

I. CLAIM STATUS

Claims 1-4 appear in this application and stand rejected. No claims have been allowed. The claims define patentable subject matter.

This paper must be entered and considered after final rejection, since it does not alter or amend the claims. Therefore, there is nothing that would require further consideration and/or search, and hence no ground for refusing entry to this paper.

Applicant requests favorable reconsideration, entry of the present paper, and formal allowance of the claims.

II. OBVIOUSNESS REJECTION

Claims 1-4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over JP 7-195618A (herein referred to as Toyo) in view of J P 05-269920 (herein referred to as Nippon) for the reasons set forth in item 3 on pages 2-3 of the Office Action.

Applicant respectfully traverses this rejection for the same reasons stated in the previous response dated April 8, 2009 with respect to the Toyo reference (which arguments are reiterated herein by reference) and for the following reasons.

The rejection should fall, because the combined prior art teachings fail to teach, suggest or make obvious all of the limitations of claim 1 (i.e., the sole independent claim), as required to support a *prima facie* case of obviousness. Specifically, claim 1 calls for a

Resin-coated metal plate for a drawn can, comprises:

a metal plate and a resin film being applied to at least one surface of the metal plate, wherein the resin film comprises:

a crystallized saturated polyester resin layer [A] that is produced from dicarboxylic acid and dihydroxy compounds, the components of dicarboxylic acid are terephthalic acid and isophthalic acid, or only terephthalic acid; and

a layer composed of resin [B] that is comprised of saturated polyester resin (i) and ionomer resin (ii),

wherein the layer composed of resin [B] is laminated on the metal plate to tightly contact with the metal plate, and

on a surface of the crystallized saturated polyester resin layer [A] is a highly crystallized layer (X) formed by a heat treatment of the resin-coated metal plate;

wherein the highly crystallized layer (X) is at least 2% of thickness of the crystallized saturated polyester resin layer [A] . [Emphasis added.]

Applicant respectfully submits that the combination of Toyo and Nippon fails to disclose or suggest a resin-coated metal plate with the above-underlined features of a “highly crystallized layer (X) formed by a heat treatment of the resin-coated metal plate” and “wherein the highly crystallized layer (X) is at least 2% of thickness of the crystallized saturated polyester resin layer on a surface on a surface of the crystallized saturated polyester resin layer [A].”

As discussed in the last response, Toyo discloses a method to obtain a drawing squeeze can by providing a resin film consisting of a resin layer on a surface of a metal plate, wherein the resin film consists of two layers: a crystalline saturated polyester resin layer and a resin composition layer. Though Toyo discloses a crystallized saturated polyester resin layer [A] and a resin layer [B], Toyo does not disclose a not a highly crystallized layer (X), as required in

claim 1 of the instant application. Therefore, it is clear that Toyo does not disclose each and every element of the metal plate as in claim 1. Indeed, the Examiner acknowledges this fact in the last paragraph on page 2 of the Office Action, wherein the Examiner states that “Toyo does not teach the film may be heat treated by heating the metal substrate prior to application.”

The Examiner relies on Nippon as allegedly teaching this missing feature of heat treatment in Toyo. In doing so, the Examiner states:

it would have been obvious to the skilled artisan to utilize the heat treatment technique of Nippon in the laminate of Toyo in order to improve the processability, heat resistance, and adhesion of the resin. The examiner takes the position that such a heat treatment will inherently result in a highly crystallized layer (X). Specifically, the amount of crystallinity achievable in a heat-treated polyester depends primarily on the heat treatment temperature. . . . Since the surface applied to the metal substrate will be the hottest, it will have the highest amount of crystallinity”.

Applicant disagrees and submits that Nippon fails to disclose or suggest that for which it is offered. In this regard, attached herewith is a machine translation of Nippon (JP05-269920). As can be seen, Nippon discloses that “the orientation crystal of resin is destroyed by heating” and “the fall of orientation crystallinity are caused with the heat at the time of a lamination” (see paragraph [0036] in the specification of Nippon). This is due to the fact that the resin film of Nippon is a “biaxially oriented film” (See paragraph [0036] in specification of Nippon). It is believed that this disclosure in Nippon actually teaches away from the use of heat treatment to achieve a “highly crystallized layer” device as in claim 1 of the instant application.

By contrast, in the device of the instant application, the resin film is substantially unoriented and uncrystallized (see, lines 14-18, page 9 of the specification). Therefore, as set forth

in the instant application and in claim 1, the heat treatment forms the highly crystallized layer (X) on a surface of the crystalline saturated polyester resin layer [A].

Accordingly, since Nippon discloses that crystallinity is destroyed by heat treatment, the skilled artisan would not be inclined to use the heat treatment in Nippon in combination with the disclosure of Toyo to achieve the “highly crystallized layer (X) formed by a heat treatment” as recited in claim 1. This teaches away from the arrangement of claim 1.

It is well established that a prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2141.02, VI. It is also well established that a prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness. M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2145, X, D, 1. Also, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2143.01, V. Likewise, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2143.01, VI.

Again, Nippon’s disclosure suggests that heat treatment would not achieve a highly crystallized layer as required in claim 1. Thus, Applicant submits that the combination of the teachings of Toyo and Nippon teaches away from each and every element of claim 1. As such, no

combination of Toyo and Nippon would predictability result in each and every element of claim 1. For this reason, the obviousness rejection fails and should be withdrawn.

Further, it is noted that the Examiner mentioned that the product of Toyo is made into a squeeze can (item 3, 2nd paragraph of the Office Action). However, the product of Toyo is actually a “drawing squeeze can” as evident by the disclosure in Toyo (see, for instance, the title), which means “drawn-ironed can”. This is different from the “drawn can” recited in claim 1 of the present application. For this additional reason, the obviousness rejection fails and should be withdrawn.

In view of the above, claim 1 is believed to be novel and patentable over the combination of Toyo and Nippon. Claims 2-4 depend, either directly or indirectly, on claim 1. Accordingly, these dependent claims are also believed to be novel and patentable over Toyo and Nippon for the same reasons given their dependency on claim 1. Thus, withdrawal of the obviousness rejection over Toyo and Nippon is requested.


III. CONCLUSION

Having addressed all the outstanding issues, this paper is believed to be fully responsive to the Office Action. Applicants respectfully request reconsideration and withdrawal of the outstanding rejections of record in view of the above amendment and remarks. It is believed that the claims are in condition for allowance. Favorable action is requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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APPENDIX:

The Appendix includes the following item(s):

- Machine translation of Nippon (JP05-269920).